

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
: Examiner: William C. Joyce
GLAESENER, PIERRE, ET AL.)
: Group Art Unit: 3682
Application No.: 09/835,439)
: Confirmation No.: 7938
Filed: April 17, 2001)
: May 25, 2006
For: FLEXIBLE SHOE ASSEMBLY)
:

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW AND
PETITION FOR EXTENSION OF TIME

Sir:

Applicants petition to extend the time for response to the February 21, 2006 final Office Action to June 21, 2006. Please charge Deposit Account 50-1710 \$120.00 for payment of the extension fee. Any additional fee required, and any overpayments, should also be charged to Deposit Account No. 50-1710.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached pages 2-6.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-12 and 27-35 are pending in the application. Claims 1, 34, and 35 are independent.

Claims 1, 7-11 and 27-35 were rejected as being unpatentable over Faint, Schlereth, and Osawa, for the reasons discussed on pages 2-7 of the final Office Action. Applicants respectfully traverse all art rejections, for at least the reasons set forth in the previously-submitted responses. Additional reasons for patentability are set forth below.

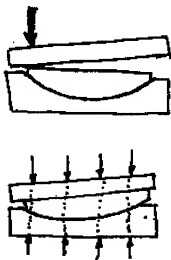
Each of the independent claims recites a novel combination of structure and/or function including, inter alia, a force redirector that is configured to ***redirect the force from a leading edge and a trailing edge of the upper wearing surface to a central area in the body.***

In the final Office Action, the Examiner states that Faint has:

...a cylindrical force redirector surface formed at a connection surface between the upper [52] and lower [54] members.

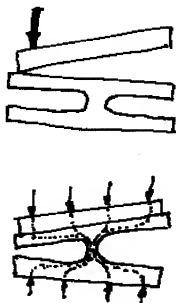
However, Applicants respectfully submit that Faint has no force redirector. Faint is a self-aligning bearing that does not redirect any force therethrough. In Faint, a

downward force vector applied to either the leading edge or the trailing edge of the upper member 52 causes relative rotation of the upper member 52 within lower member 54, but does not **move or redistribute** the downward force vector - the downward force vector is still applied through the leading or trailing edge of upper member 52 directly down through the lower member 54. In the below sketch, when a misaligned load is applied at one end of the Faint upper member, self-alignment occurs so as to distribute the load equally without directional change in the forces. Force is also equally distributed over the entire cylindrical surfaces in contact.



In contrast, in the present invention, a downward force vector applied to the leading or trailing edge of the upper support member is actually moved (i.e., redirected) to the central area of the body. With reference to the Fig. 7 embodiment, for example, when a downward force vector is

applied to edge 62 of upper support 48, that downward force vector is moved or redirected through the web 52 to the lower body 12. The force is redirected. In the below sketch, when a misaligned load is applied at one end of the upper member according to the present invention, the force is redistributed equally with a directional change in the forces. Specifically, the forces are redirected, focused, and concentrated to pass through the web.



Since Faint performs no redirection of a force applied to the leading or trailing edge of the upper member to a center of the body, the claims are fully patentable over Faint.

In the final Office Action, the Examiner states that

...it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the linear bearing of Schlereth with a linear bearing having a wear surface, as taught by Osawa, [the] motivation being to reduce the number of components of the device thereby reducing the cost and assembly time of the device.

However, in Schlereth, the load is transmitted through rows of balls 211x and 211y, (see Col. 5, lines 23-34). Contrary to the Examiner's assertion, the person of ordinary skill in the art at the time would not replace a more efficient bearing (ball bearings) with a less efficient bearing (wear plate). Such a replacement would require much more power to move (due to increased friction) the Schlereth equipment, which is contradictory to the use of wheels and ball bearings throughout the Schlereth structure. Likewise, nothing in Osawa suggests that more efficient ball bearings should be replaced with a less efficient wear plate. Thus, the person of ordinary skill in the art would not be motivated to place a wear plate in the Schlereth structure.

Moreover, the stated suggestion to combine references, "to reduce the number of components of the device thereby reducing the cost and assembly time of the device" is legally insufficient. There is nothing in any reference to suggest that Schlereth's solution to load bearing is lacking, or that a different structure should be adapted. The stated

suggestion "to reduce costs" would permit any reference to be combined with any other reference in a "pick-and-choose" hindsight approach that the courts have found legally improper. See *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Patent Office Board of Appeals 1993), and *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The suggestion to combine references must be more specific. The law is clear that the Examiner must make "findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed." (emphasis added) *In re Kotzab*, 217 F. 3d 1365, 1371 (Fed. Cir. 2000). Since the stated motivation-to-combine is woefully inadequate to support a *prima facie* case of obviousness, this rejection must be withdrawn.

For each of the above reasons, a proper *prima facie* case of obviousness has not been made out in this case, and the claims are fully patentable over the cited art, whether that art is taken individually or in combination.

In view of the above, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3507. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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